

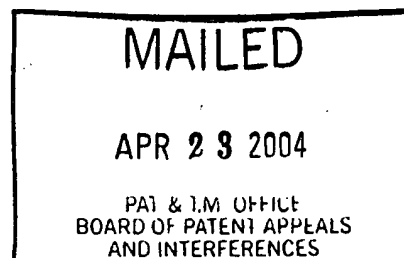
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte GREG ALAN KRANAWETTER and MARK ALAN SCHULTZ

Appeal No. 2003-1547
Application No. 09/319,326

ON BRIEF



Before KRASS, BARRY, and SAADAT, *Administrative Patent Judges*.
BARRY, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

A patent examiner rejected claims 1-17. The appellants appeal therefrom under 35 U.S.C. § 134(a). We remand.

"The review authorized by 35 U.S.C. Section 134 is not a process whereby the examiner . . . invite[s] the [B]oard [of Patent Appeals and Interferences] to examine the application and resolve patentability in the first instance." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (Bd.Pat.App. & Int. 1999). In an *ex parte* appeal, "the Board is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). Here, after

considering the record, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Braeken*, 54 USPQ2d at 1112. Our opinion addresses the following reasons for remanding:

- improper incorporation by reference
- incomplete summary of invention.

A. IMPROPER INCORPORATION BY REFERENCE

"An examiner's answer should not refer, either directly or **indirectly**, to more than one prior Office action." M.P.E.P. § 1208 (8th ed., Aug. 2001¹) (emphasis added). Here, the examiner's answer refers **indirectly** to more than one prior Office action. Specifically, it references a "rejection is set forth in prior Office Action, Paper Number 8. . . ." (Examiner's Answer at 3) The referenced Office action, in turn, references a rejection "set forth in the previous Office Action of Paper 5. . . ." (Final Rejection at 2.) Consequently, the examiner's answer indirectly refers to two Office actions.

When incorporating by reference, moreover, "[t]he page and paragraph of the final action or other single action which it is desired to incorporate by reference should

¹We cite to the version of the M.P.E.P. at the time of the examiner's answer and the appellants' brief.

neither the page nor paragraph of the action it references. Instead, it merely refers to the "rejection is set forth in prior Office Action, Paper Number 8. . . ." (Examiner's Answer at 3.)

We "decline to substitute speculation as to the rejection for the greater certainty which should come from the [examiner] in a more definite [explanation] of the grounds of rejections." *Gambogi*, 62 USPQ2d at 1212. Instead, we ask the examiner to prepare a substitute examiner's answer that explains his rejection *in toto* rather than incorporating the rejection by reference.

B. INCOMPLETE SUMMARY OF INVENTION

An appeal brief shall contain "[a] concise explanation of the invention defined in the claims involved in the appeal, which **shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.**" 37 C.F.R. § 1.192(c)(5)(2002) (emphases added).² "[I]t is preferable to read the appealed claims on the specification and any drawing." M.P.E.P. § 1206. "[R]eference to page and line number of the specification . . . is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application." *Id.*

²We cite to the version of the C.F.R. at the time of the appellants' brief.

Here, the *Summary of the Invention* section of the appellants' brief refers to neither pages and lines of their specification nor reference characters of their drawings. Nor does the section read the claims on the specification and drawings.

We decline to substitute speculation about where the claimed subject matter is described in the application for the greater certainty that should come from the appellants in a more specific summary of the invention. Instead, we ask the appellants to prepare a substitute brief that reads each of the independent claims (viz., claims 1, 10, 14, and 17), and any dependent claims argued separately, on their specification and drawings. In particular, a mapping of each of the claimed limitations to specific pages and lines of the specification and reference characters of the drawings is needed for a meaningful review.


CONCLUSION

For the aforementioned reasons, the application is remanded to the examiner for further action not inconsistent with the views expressed herein. Any subsequent answer submitted by the examiner should be self-contained with respect to all rejections and arguments. No prior answer should be referenced or incorporated therein. Similarly, any subsequent brief submitted by the appellants should be self-

contained with respect to all arguments. No prior brief should be referenced or incorporated therein.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).

Ed. M.


LANCE LEONARD BARRY
Administrative Patent Judge

Mahsid D. Dadat

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

Appeal No. 2003-1547
Application No. 09/319,326

Page 7

JOSEPH S TRIPOLI
THOMSON MULTIMEDIA LICENSING INC.
PO BOX 5312
PATENT OPERATIONS
PRINCETON, NJ 08540